REMARKS

Claims 1-4, 10, 12-14, 20-25, 37, and 40-45 stand rejected under 35 U.S.C. 101 as claiming the same identical invention as that set forth in the claims of U.S. Pat. No. 6,301,531 (Pierro). Claims 1-4, 10, 12-14, 20-25, 37, and 40-45 stand rejected as being anticipated under 35 U.S.C. 102(g) by Pierro. Claims 5-9, 11, 15-19, 26-32, 38, 39, 46, and 47 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Pierro. Reconsideration of the rejections is solicited in view of the following remarks.

REJECTIONS UNDER 35 U.S.C. 101

Applicant respectfully submits that the Office Action fails to establish a prima facie case of double patenting under 35 U.S.C. 101. MPEP § 804 II. A., citing *In Re Vogel*, 422 F.2d 438, 163 U.S.P.Q. 619 (C.C.P.A 1970), recognizes that a reliable test for scrutinizing whether one meets double patenting under 35 U.S.C. 101 requirements, is whether a claim in the application could be literally infringed without literally infringing a corresponding claim in the patent. The question to be asked in this analysis is whether there is an embodiment of the invention that falls within the scope of one claim, but not the other. The rejection lacks this necessary literal infringement analysis. A listing of what a prior art patent discloses with regard to the claims of the rejected application is insufficient to support a double patenting rejection under 35 U.S.C. 101. Moreover, a reference to what an issued patent *discloses* in the specification with regard to the claims of the rejected application is not an appropriate standard to support a double patenting rejection under 35 U.S.C. 101.

Even more significantly, if the required literal infringement analysis was conducted, then such an analysis would amply demonstrate that the claims in

question do not cover the identical subject matter as required by *Vogel*. For example, claim 1 of the present invention in part recites "providing a set of rules comprising relationships for processing the collected data to determine a plurality of operational modes for each asset, each of said operational modes being associated with a distinct level of wear in an asset" and "processing the data relative to the set of rules to develop historical information regarding actual usage of each mobile asset, the information for said actual usage being arranged so as to list a plurality of operational modes accumulated for the asset over a selectable period of time." Accordingly, the claim calls for determining an operational mode of a mobile asset and for developing historical operating information arranged according to the operational modes accumulated for the asset. The foregoing operational relationships are completely lacking in any claims of Pierro. Nothing in any claim of Pierro recites the operational relationships of determining a mode of operation of an asset and/or arranging historical operating information according to modes of operation.

Conversely, the claims of Pierro include features that are not included in any claims of the present application. For example, claim 1 of Pierro recites the operational relationship of "comparing the fault code for the vehicle with historical fault code data for similar vehicles to prioritize the fault." Nothing in any claim of the present application recites any operational relationship with respect to fault codes.

Accordingly, it can be said that the claims of the present invention and the claims of Pierro can be literally infringed without literally infringing one another. That is, the claims of Pierro could be literally infringed independently of literally infringing the pending claims and, vice versa, the pending claims could be literally infringed independently of literal infringement of Pierro. This is the only logical corollary since Pierro and the pending claims recite completely different inventions. Furthermore, it is submitted that the differences between the claims of Pierro and the rejected claims are so pointedly distinct that such claims would pass muster even under an obviousness-type double patenting scrutiny. For all

of the above reasons, withdrawal of the rejection of claims 1-4, 10, 12-14, 20-25, 37, and 40-45 is requested.

REJECTIONS UNDER 35 U.S.C. 102(g)

35 U.S.C. 102(g) provides that "a person shall be entitled to a patent unless ...(g)(2) before such person's invention thereof, the invention was made in this country by another inventor." For at least the reasons described above with regard to the double patenting rejection under 35 U.S.C. 101, applicant submits that the presently claimed invention and the invention claimed in Pierro are completely different inventions. Therefore, Pierro cannot be cited to support a rejection under 35 U.S.C. 102(g) because the invention claimed in Pierro is completely different than the present invention. Accordingly, applicant requests that the rejection to claims 1-4, 10, 12-14, 20-25, 37, and 40-45 be withdrawn.

REJECTIONS UNDER 35 U.S.C. 103(a)

It is respectfully noted that the subject matter of Pierro and the presently claimed invention, were, at the time the invention was made, owned by the same entity (General Electric Company) and/or subject to an obligation of assignment to the same entity. Consequently, Pierro cannot be used as prior art under 35 U.S.C. 103(c), to preclude patentability under section 103 of the statute. Thus, the rejection of claims 5-9, 11, 15-19, 26-32, 38, 39, 46, and 47 should be withdrawn.

It is respectfully submitted that each of the claims pending in this application recites patentable subject matter and it is further submitted that such claims comply with all statutory requirements and thus each of such claims should be allowed.

The applicant appreciates the Examiner's efforts in trying to conduct a thorough and concise examination, and cordially invites the Examiner to call the undersigned attorney if there are any outstanding items that may be resolved via telephone conference.

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Respectfully submitted,

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